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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,961	03/22/2001	Stefan Prange	112740-194	1231

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EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,961

Applicant(s)

PRANGE ET AL

Examiner

John M. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30, 32-37 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30, 32-37, 39, 40 and 42 is/are rejected.
- 7) ☒ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 22-30, 32-37,39-42 remain pending.

Claims 31 and 38 have been canceled.

Response to Arguments

The Applicants arguments filed on September 8, 2003 have been fully considered.

The amended claims are rejected in view of the newly discovered references

Albert et al. (US Patent 5,991,410).

See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-30, 32-37,39-40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No 6,442,532) in view of Terranova (US Patent 6,098,879) and further view of Rosen. (US Patent 5,953,423) and further view of Albert et al. (US Patent 5,991,410).

As per claim 22,

Kawan ('532) discloses a method for paying for goods and services using both a mobile radio device and a base telecommunication station which communicates with the mobile radio device via electromagnetic waves, the method comprising the steps of:

transmitting data required for payment from the base telecommunication station to the mobile radio device;(Column 5, lines 13-21)

asking a user, at the mobile radio device, for confirmation for the payment;(Column 8, lines 28-30, column 6, lines 7-15)

Kawan ('532) does not explicitly disclose initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. (Column 31, lines 23-29). It would be obvious to one having ordinary skill in the art at the time the invention was

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made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

Kawan ('532) does not explicitly disclose transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer. Rosen. ('423) discloses transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer(Figure 15A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Rosen. ('423) method in order to allow the transaction to be processed by an online banking system.

Kawan ('532) does not explicitly disclose writing at least some of the data required for payment to a short message memory of a mobile radio device as a readable short message, a sender telephone number entered being the telephone number of a telecommunication device of one of a financial institution and a bill issuer. Albert et al. ('410) discloses writing at least some of the data required for payment to a short message memory of a mobile radio device as a readable short message, a sender telephone number entered being the telephone number of a telecommunication device of one of a financial institution and a bill issuer (Column 17, lines 43-54, Figure 3 [although Albert et al. does not specifically discloses the telephone number of a financial institution the examiner contends that the network address of the banking institutions wireless network is analogous to the phone number of a banking institution utilizing a SMS system]). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Albert et al. ('410) method in order to allow the transaction to be processed by an online banking system.

As per claim 23,

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein the step of initiating a payment of operation includes the mobile radio device communicating directly with a telecommunication device of a financial institution.(Column 4, lines 53-60).

As per claim 24

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

herein the step of initiating a payment operation includes the mobile radio device transmitting the payment instruction data to the base telecommunication station, and the base telecommunication station transmitting the payment instruction data to a telecommunication device of a financial institution via a landline network connection.(Column 3, lines 13-26)

As per claim 25

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

converting, via the mobile radio device, the data received from the base telecommunication station into a format which is suitable for a payment operation before transmission.(Column 3, lines 34-37)

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As per claim 26

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

authenticating the user of the mobile radio device before the step of initiating the payment operation. (Column 8, lines 61-66)

As per claim 27

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 26,

wherein the user is authenticated via at least one of a personal identification number entry and biometric features. (Column 8, lines 61-66; column 9, lines 1-3)

As per claim 28

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein an electronic cash register transmits the data required for payment to the base telecommunication station.

As per claim 29

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22.

Kawan ('532) does not explicitly disclose transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer. (Column 31, lines 55-67; column 32, lines 1-9). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity by authenticating the user.

Official Notice is taken that "transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer" is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 30

Kawan ('532) discloses a method for paying for goods and services as claimed in
Kawan ('532) does not explicitly disclose the key is used at least on particular transmission paths to encrypt data which is to be transmitted. Terranova ('879) discloses the key

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is used at least on particular transmission paths to encrypt data which is to be transmitted (Column 30, lines 39-44). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity.

As per claim 32

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

Kawan ('532) does not explicitly disclose transmitting a short message containing data required for payment to the telecommunication device of one of the financial institution and the bill issuer after the short message has been read and after appropriate confirmation by the user. Albert et al. ('410) discloses transmitting a short message containing data required for payment to the telecommunication device of one of the financial institution and the bill issuer after the short message has been read and after appropriate confirmation by the user (Column 17, lines 43-54, Figure 3 [although Albert et al. does not specifically disclose the telephone number of a financial institution the examiner contends that the network address of the banking institutions wireless network is analogous to the phone number of a banking institution utilizing a SMS system]). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Albert et al. ('410) method in order to allow the transaction to be processed by an online banking system.

Kawan ('532) does not explicitly disclose the feature of "automatically transmitting " the examiner contends that the mere automation of a process does not establish novelty (*In re Venner*, 120 USPQ 192,194)

As per claim 33

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

Kawan ('532) does not explicitly disclose the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the basis of a mobile radio standard. Terranova ('879) discloses the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the basis of a mobile radio standard. (Column 31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to promote interoperability of commercial systems.

As per claim 34

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 29.

Kawan ('532) does not explicitly disclose comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. Terranova ('879) discloses comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. (Column

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31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

As per claim 35

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 29.

Official Notice is taken that "the key is transmitted together with at least one of data required for the payment operation and acknowledgement data for the payment operation." is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 36

Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

wherein the data required for payment includes at least one of a sum of money which is to be paid, a name for the goods to be paid for, a name for the service to be paid for, a recipients account number, a bank sort code, a purpose of use, a customer (Column 6, lines 39-57).

As per claim 37

Kawan ('532) discloses a system for securely paying for goods and services, comprising: a base telecommunication station having a radio device for transmitting data required for payment to a mobile radio device and for receiving data from the mobile radio device; the mobile radio device which includes a reception device for receiving the data transmitted by the base telecommunication station, (Column 5, lines 13-21)

an interrogation device connected to the reception device for requesting confirmation for the payment, (Column 8, lines 28-30)

wherein the mobile radio device further includes a conversion device, connected to a reception device, for converting the data received into a format which is suitable for a payment operation (Figure 1 [obviously there is a conversion of data between a wireless format and a network format i.e a broadcast signal to a signal on a wire])

Kawan ('532) does not explicitly disclose transmission device connected to the interrogation device for transmitting data for at least one of initiating a payment operation and transmitting acknowledgement data for the payment operation to the base telecommunication station. Terranova ('879) discloses transmission device connected to the interrogation device for transmitting data for at least one of initiating a payment operation and transmitting acknowledgement data for the payment operation to the base telecommunication station. (Column 31, lines 23-29). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

As per claim 39

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Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37, the system further comprising:

an electronic cash register connected to the base telecommunication station, the electronic cash register designed to transmit the data required for payment to the base telecommunication station.(Figure 2A).

As per claim 40

Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37,

Kawan ('532) does not explicitly disclose a computing device, associated with the base telecommunication station, for at least one of producing and verifying a key. Terranova ('879) discloses a computing device, associated with the base telecommunication station, for at least one of producing and verifying a key. (Column 31, lines 55-67; column 32, lines 1-9). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity by authenticating the user.

As per claim 42

Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37,

wherein the data required for payment includes at least one of a sum of money which is to be paid, a name for the goods which are to be paid for, a name for the services which are to be paid for, a recipients account number, a bank sort code, a purpose of use, a customer number, and a telephone number of a telecommunication device of one of a financial institution and a bill issuer.(Column 6, lines 39-57)

Allowable Subject Matter

Claim 41 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references

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in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW

November 27, 2005

John Winter
PRIMARY EXAMINER